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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,062	08/01/2003	Christopher J. Dyl	19815-015001	3611
26161	7590	04/02/2009	EXAMINER	
FISH & RICHARDSON PC			LEIVA, FRANK M	
P.O. BOX 1022			ART UNIT	PAPER NUMBER
MINNEAPOLIS, MN 55440-1022			3714	
NOTIFICATION DATE		DELIVERY MODE		
04/02/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/633,062	<b>Applicant(s)</b> DYL, CHRISTOPHER J.
	<b>Examiner</b> FRANK M. LEIVA	<b>Art Unit</b> 3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

1) Responsive to communication(s) filed on 30 October 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-23 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-23 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application  
6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30 October 2008 has been entered.

### ***Acknowledgements***

2. The examiner acknowledges amendments to claims 1-6, 12-16, 18, 20 and 22-23 in applicant's submission filed 30 October 2008.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

4. As for the argument directed to the combination of the Walker and Nakano references as being "mere conclusory statements", the examiner points the applicant's attention to MPEP §2143 rational D;

D. Applying a Known Technique to a Known Device (Method, or Product) Ready for Improvement To Yield Predictable Results. To reject a claim based on this rationale, Office personnel must resolve the Graham factual inquiries. Then, Office personnel must articulate the following:

- (1) a finding that the prior art contained a "base" device (method, or product), (Walker; win activated product), upon which the claimed invention can be seen as an "improvement;"
- (2) a finding that the prior art contained a known technique that is applicable to the base device (method, or product), (Nakano; dissemination control of a product);

- (3) a finding that one of ordinary skill in the art would have recognized that applying the known technique would have yielded predictable results and resulted in an improved system, (the fact that once the product exchanged by Walker is a copyright protected product, the need to look for already invented methods for controlling the dissemination of the product is required before licensing for sale of the product); and
- (4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claim would have been obvious is that a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art. One of ordinary skill in the art would have been capable of applying this known technique to a known device (method, or product) that was ready for improvement and the results would have been predictable to one of ordinary skill in the art. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art. The rational comes from the basis that Walker can sell anything that can be found in any virtual or WEB store including CDs, MPEGs, or Videos that have a limited shelf life, and to sell any of these products Walker would have to add any limiting copyright protection system including that of Nakano.

#### ***Claim Rejections - 35 USC § 112***

- 5. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amended limitations "receiving information indicating that a plurality of players is playing the online game on each of a corresponding plurality of clients", and "receiving information indicating that a first player

from the plurality of players has completed a game challenge associated with the goal-activated content", are not positively addressed in the specifications and would be considered new matter.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-19 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 6,443,843 B1), in view of Nakano (US Pub. 2002/0120667 A1).**

8. Walker discloses a betting game where upon winning, the prize is a product which includes upon any type of sale product including Objects, content, media etc.; Nakano discloses a system of controlling distributing of multi-media content such as MPEGs by deleting the content from the storage if the allotted time for use has expired.

9. Regarding claims 1, 6 and 13; Walker discloses a method of providing a product (content, DVDs, CDs, MPEGs, etc.), in an online game, the method comprising: at a server hosting, for transmission, of product certificates (multi-media content) designated as goal-activated content for an online game;

receiving information indicating that a plurality of players is playing the online game on each of a corresponding plurality of clients, (col. 6:35-52), where a plurality of customers linked through a network connection play simultaneously, the customers assigned registered devices which will have to sign on and indicate presence in the network; receiving information indicating that a first player from the plurality of players

has completed a game challenge associated with the goal-activated content, (col. 4:6-25); in response to receiving the information indicating that a first player from the plurality of players has completed a game challenge associated with the goal activated content transmitting the goal-activated content to a first client associated with the first player, (col. 1:60- 2:10, col. 2:56-62, col. 3:50-56 and col. 4:6-25);

Walker fails to disclose the specifics limiting dissemination of multi-media content; Nakano discloses distributing copy protected media and limiting the dissemination of multi-media content including instructing the client to delete the content stored on the client, (¶ [0061]).

All of the component parts are known in Walker and Nakano the only difference is that dissemination or sale of a copy protected MPEG is describe in the virtue of a WEB store and Walker describe the purchasing or winning of products from a WEB store, including such as MPEGs or Videos. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use all available WEB store teachings for the stores used in Walker's invention.

**10. Regarding claims 2, 11 and 14;** Walker discloses wherein transmitting the goal-activated content comprises transmitting the goal-activated content to the first client in response to a determination that the first player has completed the game challenge, (fig. 8, col. 2:56-62) the challenge of course is the winning outcome.

**11. Regarding claims 3, 8 and 16;** Walker discloses receiving a history profile from the first client; maintaining a history profile having information about goal-activated content received from the server and sending the history profile to the server, (fig. 5, col. 10:51-67 and 11:30-39), the history profile such as a customer identification number would be received by the system, Indicating the customer's rating and latest purchases and winnings.

**12. Regarding claims 12 and 15;** Walker discloses wherein requesting goal-activated content from the server comprises requesting goal-activated content in response to the completion of the challenge, and authentication (col. 14:11-22, fig. 5).

**13. Regarding claims 4, 9 and 17;** Walker and Nakano disclose all the limitations of claims 1, 3, 6 and 8 as applied above and Nakano further discloses wherein instructing the first client to delete the goal-activated content comprises instructing the first client to delete goal-activated content stored on the first client in accordance with the history profile, (¶ [0112-117]), wherein the system according to the pause, stop and play commands history calculates how much time is left for viewing the content. It would have been obvious upon reading Nakano to include checking history for proper time periods spent or history of the account to control the deletion system, allowing the player the flexibility to observe the content at his/hers own timeline. It would be predictable to add the history profile to the time limiting aspect of protected content to the already modified Walker/Nakano invention as declared in claims 1, 6 and 13.

**14. Regarding claim 5;** Walker and Nakano disclose all the limitations of claim 1 as applied above and Nakano further discloses encrypting the goal-activated content prior to transmission to the first client, (¶ [0058, 0105]), inherent in MPEG files is coded/encrypted materials for the purpose of limiting play to specific media providers. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use the time encryption method in Nakano to establish the viewable period.

**15. Regarding claims 7 and 19;** Walker and Nakano disclose all the limitations of claims 6 and 13 as applied above and Nakano further discloses wherein receiving an instruction from the server to delete goal-activated content comprises receiving, upon initialization of an executable program, an instruction to delete the goal-activated content, (¶ [0068]), as discussed above, Nakano limitations directed to the deletion of content are introduced into Walkers Web stores and thus would all be predictable included parts of the combination of Walker and Nakano.

**16. Regarding claims 10 and 18;** Walker and Nakano disclose all the limitations of claims 6 and 13 as applied above and Nakano further discloses wherein receiving an instruction from the server to delete goal-activated content comprises receiving an instruction to delete all goal-activated content stored on the client, (¶ [0006]). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the "delete all content" feature of Nakano with the Walker/Nakano invention as described in claims 1, 6 and 13 as it would to include all special features taught by Nakano upon reading Nakano's invention. It would be obvious to try all elements taught in the invention in order to attempt to maximize improvement of Walker/Nakano invention making it more versatile and easy to use.

**17. Regarding claim 21;** Walker/Nakano as described above in claims 1, 6 and 13; disclose a method for controlling access to multi-media content by clients in a multiplayer game, the method comprising: maintaining a state for each player in a multiplayer game, (Walker col. Fig. 8); storing multi-media content for distribution to clients associated with the players in the game, including storing content in association with each of a plurality of states that can be reached by at least some of the players, (Walker col. 3:50-58); determining that a first player associated with a first client has reached a first state, and permitting access to said multi-media content by the first player, (Walker fig. 8), wherein the combination is obvious to one of ordinary skill in the art as described above in claims 1, 6 and 13.

**18. Regarding claims 22 and 23;** Nakano/ Walker disclose all the limitations of claim 21 as applied above and from which claims 22 and 23 depend on, yet Nakano is silent to the type of content being of goal activated. Walker as disclose above is of analogous art and discloses the achievement of items or content upon the reaching of certain goals. Walker discloses with respect to claim 22; wherein the state for a player comprises the state of having completed a game challenge, (col. 2:56-62), where the game is continually judging the state of the player (win/loss) in each game challenge;

the challenge of winning the game. Also Walker discloses with respect to claim 23; wherein determining whether the first player associated with the first client has reached the first state comprises determining whether the player has completed a game challenge, (col. 2:56-62), (has the player won?). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the well-known goal activated features of Walker into the invention of Nakano in order to be a more interesting and entertaining experience for a subscriber to the WEB store.

**19. Claims 20 is rejected under 35 U.S.C. 103(a) as being obvious over Nakano (US Pub. 2002/0120667 A1), in view of Walker (US 6,443,843 B1).**

**20. Regarding claim 20; Nakano discloses:**

A computer-based multi-media content dissemination-limiting apparatus, (Abstract).

A non-volatile memory element storing data representative of multi-media content, (¶ [0056]), hard disk.

A transceiver for receiving a connection request from a remote client on a network, (¶ [0055]), Internet network connection inherently contains receivers/transmitters for connection.

A processor configured for determining that the content is to be transmitted to the client; causing the transceiver to transmit the goal-activated content, (¶ [0075]).

Causing the transceiver to transmit a deletion instruction for deleting the goal-activated content from the client, (¶ [0068]), instruction of deletion having been sent.

Nakano is silent to the nature of the content to being goal activated yet it speaks of being a game content.

Walker discloses designating content as goal-activated content, (col. 17:65-col. 18:2]), disclosing the need for the player to reach a goal or winning the game before he/she is allowed to that content. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the goal activated feature of Walker

in Nakano's invention to make a WEB store more interesting for subscribers. More so both references describe forms of obtaining products via a WEB store and any combination of the teachings would be obvious to one of ordinary skill in the art at the time of applicant's invention and predictable.

**21. Examiner's Note:** Examiner has cited paragraphs and figures in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

**22.**

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK M. LEIVA whose telephone number is (571)272-2460. The examiner can normally be reached on M-Th 9:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FML

03/26/2009.

/Peter D. Vo/

Supervisory Patent Examiner, Art Unit 3714